This Amendment is responsive to the Office Action mailed June 8, 2006.

In the Office Action, claims 6, 29 and 52 were rejected under 35 U.S.C. §112(1) as failing to comply with the enablement requirement. Claims 1, 24 and 47 are rejected under 35 U.S.C. §112(2). Claims 1, 3-5, 9-24, 26-28, 32-47, 49-51 and 55-69 are rejected under 35 U.S.C. §103(a) as being unpatentable over Barnes & Noble (B&N) in view of Hartman et al. (U.S. Patent No. 5,960,411). Claims 1, 3-7, 9-24, 26-30, 32-47, 49-53 and 55-69 are currently pending.

35 U.S.C. §112(1) Rejection

Claims 6, 29 and 52 are cancelled herewith. Applicants thank the Examiner for pointing out the inconsistency of these claims relative to their respective independent claims. As these claims are cancelled, the 35 U.S.C. §112(1) rejections applied thereto are now believed to be moot.

35 U.S.C. §103(a) Rejection over B&N in View of Hartman

At the outset, it is noted that the Office Action mailed February 10, 2006, rejected these same claims as being <u>anticipated</u> by B&N. The Amendment filed March 31, 2006, was effective to overcome this rejection. In other words, the claims are <u>not anticipated</u> by B&N. The Office now rejects the claims as being obvious over B&N <u>in view of Hartman</u>. That is, the Office relies upon the teachings of Hartman to supply the teachings, suggestion and/or motivation that are acknowledged to be missing from B&N. Therefore, unless Hartman teaches or suggests the subject matter acknowledged to be missing from B&N (or does not teach what the Office asserts that it does), then the outstanding rejection under §103(a) **must** be withdrawn and the application allowed.

Turning first to the B&N reference, independent claim 1 recites:

> **receiving, over the computer network, a first online purchase request for a first item;**
> **responsive to receiving the first online purchase request, providing a bifurcated order processing route that requests the customer to choose a first order processing route or a second order processing route, the first order processing route causing the first online purchase request to be processed according to an express processing procedure that requires no further input by the customer to execute the first online purchase request, the second order processing route causing the first online purchase request to be placed in a shopping cart that allows one or more additional purchase requests for additional items to be placed therein, the second order processing route affording the customer an opportunity to cause execution of the first and any additional purchase requests placed in the shopping card to be processed according to the express ordering processing that requires no further input by the customer to execute.**

It is respectfully submitted that B&N does not teach such a bifurcated order processing route. In particular, B&N does not teach any second order processing route that affords the customer an opportunity to cause execution of the first and any additional purchase requests placed in the shopping cart according to the express order processing route that requires no further input by the customer to execute. B&N teaches to place items in a shopping cart, but does not teach processing the shopping cart according to the express order processing route that requires no further input by the customer.

In support of the rejection, the Office points to pages **12**, **13**, **28** and **37** of B&N as allegedly teaching the enumerated claim elements. B&N teaches, at page **12** of 35, at "How to Check Out the Items in Your Cart" to

1) click the shopping cart link;

2) click Checkout Now;

3) enter customer information (if not already in the system;

4) click Continue; and

5) click Press Here to Send My Order.

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As the Examiner can see, this protracted process requires lots of "input by the customer to execute" and cannot be likened to the underlined claimed causing "execution of the first and any additional purchase requests placed in the shopping cart according to the express order processing route that requires no further input by the customer to execute." Likewise, the section on page **13** of B&N referred to by the Office in the "How to Place an Order Using Express Lane" section does not teach any method or means for causing "execution of the first and any additional purchase requests placed in the shopping cart according to the express order processing route that requires no further input by the customer to execute," as claimed. Throughout the description of B&N's "Express Lane," the customer's purchase is referred to as "the item" (note the singular), and not as a shopping cart.

In addition to paged 12 and 13 discussed above, the Examiner also pointed to page **28**. As can be plainly seen, item 2 calls for "Click on the Express Checkout button. You'll be taken to a secure Confirmation Page which contains your shipping, billing and payment information." Item 3. states "Click the "Place Order" button. Therefore, B&N explicitly teaches that clicking a "Place Order" button (item 3) is necessary after a user clicks on the "Express Checkout" button (item 2) – this is a "further input" that is required, in contradistinction to the claimed embodiment. Therefore, page **28** of B&N also does not teach any method or means for causing "execution of the first and any additional purchase requests placed in the shopping cart according to the express order processing route that requires no further input by the customer to execute," as claimed.

Lastly, page **37** of B&N teaches the same process whereby a user must first click on the "Express Checkout" button (item 2. on page 37) and thereafter must click on the "Place Order" button (item 3. on page 37), which is contrary to the claims, which require "execution of the first and any additional purchase requests placed in the shopping cart according to the express order

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processing route that requires <u>no further input by the customer to execute</u>." (Underlining for emphasis only).

The Office, at page 6, states that "Hartman teaches that shopping cart can be processed using express ordering processing." This is assertion is not supported by Hartman. Hartman discloses enabling a single action (usually, a single mouse click) ordering functionality. After selecting and item and single action ordering, the customer is given an opportunity to review change the single action order (Col. 5, lines 3-9). To help minimize shipping costs and purchaser confusion, the server system may combine various single-action orders (Col 5, lines 26-28). Hartman's server system may also combine single action orders that are placed within a certain time period (e.g., 90 minutes). Orders placed may be combined or divided, based upon availability of the items ordered (Col. 4, lines 47-55, Col. 7, lines 24-56). Hartman then teaches an algorithm for expedited order selection. The stated goal for this algorithm is to reduce the shipping costs (Col. 8, line 1 through Col. 9, line 7).

In the background section of this reference, Hartman speaks of the drawbacks inherent in the shopping cart model:

> Although the shopping cart model is very flexible and intuitive, it has a downside in that it requires many interactions by the purchaser. For example, the purchaser selects the various items from the electronic catalog, and then indicates that the selection is complete. The purchaser is then presented with an order Web page that prompts the purchaser for the purchaser-specific order information to complete the order. That Web page may be prefilled with information that was provided by the purchaser when placing another order. The information is then validated by the server computer system, and the order is completed. Such an ordering model can be problematic for a couple of reasons. If a purchaser is ordering only one item, then the overhead of confirming the various steps of the ordering process and waiting for, viewing, and updating the purchaser-specific order information can be much more than the overhead of selecting the item itself. This overhead makes the purchase of a single item cumbersome. Also, with such an ordering model, each time an order is placed sensitive information is transmitted over the Internet. Each time the sensitive information is transmitted over the Internet, it is susceptible to being intercepted and decrypted (Col. 2, lines 26-48).

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Thereafter, Hartman makes it clear that the single-action ordering scheme disclosed therein is not related to the shopping cart model whose disadvantages are outlined in the background section. Indeed, specifically addressing the disadvantages of the shopping cart model outlined in the Background section, Hartman's claim 1 recites that the item ordered via the single-action model is *"ordered without using a shopping cart ordering model."* Hartman claim 1, lines 35-36). In addition, Hartman's claim 11, at lines 28-30, recites *"...whereby the item is ordered independently of a shopping cart model and the order is fulfilled to complete a purchase of the item."*

Fig. 1A of Hartman makes it abundantly clear, moreover, that the 1-click ordering scheme disclosed therein is designed for ordering an <u>item</u> - and not for processing the contents of a <u>shopping cart</u>. Indeed, the reference to 1-click in Hartman's Fig. 1A is grouped under the reference numeral 103, which relates to purchasing a single item, as opposed to reference numeral 102, which relates to the shopping cart model (Col. 4 lines 4-33). There does not appear to be any teaching or suggestion in the Hartman reference of applying the 1-click model to the contents of a shopping cart. Such would be contrary to the claims in this patent, and would not address any of the disadvantages identified in the Background section thereof. It is to be noted that Hartman is very specific as to the use of the disclosed single action or "1-click" ordering scheme: "This example single-action ordering section allows the purchaser to specify with a single click of a mouse button to order <u>the described item</u>" (Col. 4, lines 31-33) (Emphasis Added). Hartman pointedly does <u>not</u> state or suggest that the single action ordering section allows the purchaser to specify with a single click of a mouse button to order the items in the shopping cart - and explicitly teaches away from such a concept, for the reasons identified in Hartman's own Background section.

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In direct contrast, the independent claims on appeal recite:

> **…the second order processing route affording the customer an opportunity to cause execution of the first and any additional purchase requests placed in the shopping card to be processed according to the express ordering processing that requires no further input by the customer to execute.**

Recognizing the above-detailed shortcomings of the Hartman reference, the Office has previously explicitly stated that the Hartman reference fails to teach such claimed steps and features. Indeed, that the Hartman et al. reference does not teach the presently claimed second order processing route whereby the customer is afforded the opportunity to cause execution of the first and any additional purchase requests placed in the shopping cart to be processed according to the express ordering processing that requires no further input by the customer has been, in fact, acknowledged by the Examiner, at page 5, first full paragraph of the Office Action of **June 18, 2003**, which states: "***Hartman et al. does not disclose the automatic checking out of the shopping cart***." The Office Action continues and states: "However, Hartman et al. discloses that in some models when a purchaser selects any one item, then that item is "checked out" by automatically prompting the user for the billing and shipment information (Col. 2, lines 24-47)." It is respectfully submitted that checking out a shopping cart by prompting the user for billing and shipment information does not teach or suggest (whether considered singly or in combination with the secondary references) the claimed limitation of "…purchase requests placed in the shopping card to be processed according to the express ordering processing that requires no further input by the customer to execute," as claimed in the independent claims. How can Hartman et al. be said to teach processing a shopping cart according to the express ordering processing that requires no further input by the customer to execute, when Hartman et al. explicitly states that the customer must input billing and shipment information to process a shopping cart? The answer is that it cannot.

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However, the Office repeatedly ignores both the plain teachings of Hartman et al. and its own previous statements (Office Action mailed June 18, 2003) that Hartman et al. does not teach the claimed subject matter. Ignoring both what Hartman et al. actually teach as well as its own previous statements, the Office now once again states: "Hartman teaches that shopping cart can be processed using express ordering processing [Hartman, Fig. 4 and disclosure associated with Fig. 4]). The Patent Office cannot have it both ways. The Office cannot assert in one Office Action that Hartman et al. teach express ordering of shopping carts and in other Office Actions assert that it does not. The plain and explicit teachings of Hartman et al. are that Hartman et al.'s claim 1 recites that the item ordered via the single-action model discussed in Fig. 4 is *"ordered without using a shopping cart ordering model"* (Hartman et al. claim 1, lines 35-36). In addition, Hartman et al.'s claim 11, at lines 28-30, recites *"...whereby the item is ordered independently of a shopping cart model and the order is fulfilled to complete a purchase of the item."* In addition, Fig. 4 and its associated description at Col. 7, lines 4-23 describe how to generate a Web page in which such single-action ordering is enabled. Such Web page includes information such as the customer's name and a portion of the customer's credit card information. Fig. 5, beginning at Col. 7, line 24, describes how a single-action ordering for an item may be combined with other items ordered via the single-action ordering mechanism (if combined within 90 minutes, for example), in order to save on shipping costs. However, Hartman et al., contrary to what is asserted by the Office, do not teach the presently claimed second order processing route whereby the customer is afforded the opportunity to cause execution of the first and any additional purchase requests placed in the shopping cart to be processed according to the express ordering processing that requires no further input by the customer, as previously acknowledged by the Office, as shown above.
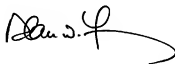
In view of the above, it is respectfully submitted that the applied combination is not effective to render the claimed subject matter obvious. Indeed, the claims have previously been distinguished over the B&N reference within the context of anticipation. In the most recent Office Action, the Office added the Hartman et al. reference to supply the teachings acknowledged to be missing from the B&N reference. However, this secondary reference itself has previously been acknowledged to <u>not</u> teach what is now asserted that it <u>does</u> teach. In addition, the arguments above effectively <u>demonstrate</u> that the Hartman et al. reference does not teach the subject matter acknowledged to be missing from the primary reference. Therefore, it is respectfully submitted that the applied combination of B&N and Hartman et al. does not teach or suggest the claimed subject matter, whether the references are considered singly or in combination as they must in the context of a §103(a) rejection. Reconsideration and withdrawal of the obviousness rejection applied to the independent claims and their respective dependent claims are, therefore, respectfully requested.

It is believed that each of the Examiner's concerns, objections and rejections have been addressed and/or overcome, as appropriate. Applicants, therefore, believe that this application is now in condition for allowance.

If any unresolved issues remain, please contact the undersigned attorney of record at the telephone number indicated below and whatever is necessary to resolve such issues will be done at once.

No fees are believed to be due herewith, however, the Director is hereby authorized to charge any fees which may be required under 37 C.F.R. §1.16 and §1.17, to Deposit Account No. 15-0635, referencing OID-2000-128-01.

Respectfully submitted,

Date: September 8, 2006 By:

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